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# Fax Memo

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| **TO:** | **Mail Stop AF**<br>**USPTO** |
| **FAX NO.:** | **(571) 273-8300** |
| **FROM:** | **Terry W. Kramer**<br>**KRAMER & AMADO, P.C.** |
| **DATE:** | **February 8, 2006** |
| **SUBJECT:** | **U.S. Patent Application**<br>**Title: METHOD AND APPARATUS FOR REVOCATION LIST MANAGEMENT**<br>**Serial No.: 09/456,689**<br>**Attorney Docket No.: A 23871** |
| **PAGES:** | **(INCLUDING COVER PAGE) 13** |



**Message:** Submitted herewith are the following:

- Transmittal Form( 1 page)
- Fee Transmittal Form (2 pages)
- Notice of Appeal (1 page)
- Credit Card Form for $500.00 (2 pages)
- Pre-Appeal Brief Request for Review (6 pages)

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# TRANSMITTAL FORM

*(to be used for all correspondence after initial filing)*

Total Number of Pages in This Submission: 12

| | |
|---|---|
| Application Number | 09/456,689 |
| Filing Date | December 09, 1999 |
| First Named Inventor | Michael S. Pasieka |
| Art Unit | 2136 |
| Examiner Name | Pramila Parthasarathy |
| Attorney Docket Number | A 23871 |

## ENCLOSURES *(Check all that apply)*

- [x] Fee Transmittal Form
  - [x] Fee Attached
- [ ] Amendment/Reply
  - [ ] After Final
  - [ ] Affidavits/declaration(s)
- [ ] Extension of Time Request
- [ ] Express Abandonment Request
- [ ] Information Disclosure Statement
- [ ] Certified Copy of Priority Document(s)
- [ ] Reply to Missing Parts/ Incomplete Application
  - [ ] Reply to Missing Parts under 37 CFR 1.52 or 1.53
- [ ] Drawing(s)
- [ ] Licensing-related Papers
- [ ] Petition
- [ ] Petition to Convert to a Provisional Application
- [ ] Power of Attorney, Revocation Change of Correspondence Address
- [ ] Terminal Disclaimer
- [ ] Request for Refund
- [ ] CD, Number of CD(s) _____
  - [ ] Landscape Table on CD
- [ ] After Allowance Communication to TC
- [ ] Appeal Communication to Board of Appeals and Interferences
- [x] Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
- [ ] Proprietary Information
- [ ] Status Letter
- [ ] Other Enclosure(s) (please identify below):

Remarks

## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

| | | | |
|---|---|---|---|
| Firm Name | Kramer & Amado, P.C. | | |
| Signature | Terry W. Kramer | | |
| Printed name | Terry W. Kramer | | |
| Date | February 8, 2006 | Reg. No. | 41,541 |

## CERTIFICATE OF TRANSMISSION/MAILING

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# PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): A 23871

I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office (Fax No. (571) 273-8300)
on 2/8/2006
Signature: Angelica PS
Typed or printed name: Angelica Rodriguez

| Application Number | Filed |
|---|---|
| 09/456,689 | 12/09/1999 |

First Named Inventor: Michael S. Pasieka

| Art Unit | Examiner |
|---|---|
| 2136 | Pramila Parthasarathy |

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- ☐ attorney or agent of record. Registration number _____
- ☑ attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34: 41,541

Terry W. Kramer
Signature
Terry Kramer
Typed or printed name
703-519-9801
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February 8, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☑ *Total of 1 forms are submitted.

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PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

| | | |
|---|---|---|
| In re Application of | : | Michael S. Pasieka |
| For | : | METHOD AND APPARATUS FOR REVOCATION LIST MANAGEMENT |
| Serial No.: | : | 09/456,689 |
| Filed | : | December 09, 1999 |
| Art Unit | : | 2136 |
| Examiner | : | Pramila Parthasarathy |
| Att. Docket | : | A 23871 |
| Confirmation No. | : | 6774 |

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

**REMARKS**

This is in response to the Final Office Action dated December 19, 2005.

MAIN REJECTION UNDER 35 U.S.C. § 102

Claims 1, 16 and 17 are independent claims. For purposes of this pre-appeal brief request, claim 1 is representative.

Claims 1-10 and 12-20 stand rejected under 35 U.S.C. § 102(e) as being anticipated by US Patent 6,389,538 to Gruse et al., hereinafter "Gruse."

Claim 11 was found allowable by the Examiner if rewritten in independent form.

Application No: 09/456,689
Attorney's Docket No: A 23871
Pre-Appeal Brief Request for Review

The present invention relates to a method, an apparatus and an article of manufacture for management of a revocation list. Claim 1 is directed to a method for controlling access to information comprising the steps of **maintaining a contact list** for a given entity and utilizing the contact list **in conjunction with a revocation list** associated with the given entity. The contact list comprises information identifying one or more other entities which have attempted to communicate with the given entity. The revocation list is used to determine which other entities are authorized to communicate with the given entity. Claim 16 is directed to an apparatus comprising a processor-based device adapted to implement the method of Claim 1. Claim 17 is directed to an article of manufacture comprising a storage medium containing software adapted to implement the method of Claim 1.

Applicant respectfully submits that in the rejections of Claims 1, 16 and 17 under 102(e) over Gruse the Examiner failed to establish a *Prima Facie* case of anticipation.

**Requirements for a *Prima Facie case* of anticipation under Section 102:**

The test for anticipation under section 102 is whether each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131. The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Circ. 1989); MPEP §2131. The elements must also be arranged as required by the claim. *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

Applicant submits that Gruse does not teach each and every element as set forth in Claim 1, either expressly or inherently.

In particular, Gruse fails to teach the step of maintaining, for a given entity, a contact list comprising information identifying other entities which have attempted to communicate with the given entity.

Gruse is directed to a system for tracking end-user electronic content usage. What Gruse describes (Col. 45:17-56) is a "Clearinghouse", which maintains a list of revoked digital certificates, not a "contact list comprising information identifying other entities which have attempted to communicate with" the Clearinghouse - in as much as the Clearinghouse of Gruse may be construed as the "given entity" of Claim 1, as the Examiner seems to do. The system described by Gruse actually corresponds to the conventional technique described in the "Background of the Invention" section of the present application (page 2, line 12 to page 3, line 11). In this kind of system an issuing authority (clearinghouse) maintains and periodically publishes an updated list of revoked identifiers. This updated list is communicated to each access control system (end user), which in turn uses said updated list to update its own, local revocation list. In the system described by Gruse there is no "contact list" used in conjunction with the "revocation list" as set forth in Claim 1. In the Final Office Action dated December 19, 2005, (page 4, lines 3-10) the Examiner cites two lists that are used by the Clearinghouse, and misconstrues one of them as the "contact list". A careful reading of Gruse shows that the two lists maintained by the Clearinghouse are: 1. a list of all the digital certificates that have been assigned; and 2. a list of the subset of digital certificates that have been revoked.

Accordingly, Applicant submits that Claim 1 is patentable over Gruse because Gruse does not teach each and every element as set forth in Claim 1. Additionally, Claims 2-15 ultimately depend from Claim 1 and are therefore also patentable over Gruse.

Regarding Claims 16 and 17, the Examiner stated in the Final Office Action dated December 19, 2005, that the limitations "a processor-based device" (Claim 16) and "a

machine-readable storage medium containing one or more software programs for use in controlling access to information" (Claim 17) have "not been given patentable weight because the recitation occurs in the preamble." Applicant respectfully, but strongly traverses this assertion, and submits that these limitations should be given full patentable weight. The MPEP, §2111.02 sets forth the effect of the preamble on patentability as follows:

> "The determination of whether a preamble limits a claim is made on a case-by-case basis in light of the facts in each case; there is no litmus test defining when a preamble limits the scope of a claim. *Catalina Mktg. Int'l v. Coolsavings.com, Inc.*, 289 F.3d 801, 808, 62 USPQ2d 1781, 1785 Fed. Cir. 2002)."

The Examiner did not provide any arguments supporting the decision to deny any patentable weight to the preambles of Claims 16 and 17.

Furthermore, Applicant submits that the Examiner did in fact mistakenly place the above-recited limitations in the preambles of Claims 16 and 17 when they are actually not part of said preambles. These limitations are recited after the transitional phrase "comprising" and should therefore be given full weight in defining the scope of the claims, as set forth in the MPEP, §2111.03:

> "The **transitional phrases "comprising"**, "consisting essentially of" and "consisting of" **define the scope of a claim** with respect to what unrecited additional components or steps, if any, are excluded from the scope of the claim." see also:
> "*Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) (**"Comprising" is a term of art used in claim language which means that the named elements are essential**, but other elements may be added and still form a construct within the scope of the claim.)"

Accordingly, Applicant submits that the limitations "a processor-based device" (Claim 16) and "a machine-readable storage medium containing one or more software programs for use in controlling access to information" (Claim 17) should be given their full and due patentable weight, and that the cited art reference does not teach or suggest

these limitations in conjunction with the other patentable features as set forth in Claims 16 and 17. Additionally, Claims 18-20 ultimately depend from either Claim 16 or Claim 17 and are therefore also patentable over the cited art reference.

**Conclusion**

While we believe that the instant pre-appeal brief places the application in condition for allowance, should the Examiner have any further comments or suggestions, it is respectfully requested that the Examiner telephone the undersigned attorney in order to expeditiously resolve any outstanding issues.

In the event that the fees submitted prove to be insufficient in connection with the filing of this paper, please charge our Deposit Account Number 50-0578 and please credit any excess fees to such Deposit Account.

Respectfully submitted,
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Date: February 8, 2006